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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------------|------------------|
| 10/773,823 | 02/06/2004 | Bernhard Keppler | 8182-26US(PA33012US-SK089 | 7951 |

570 7590 02/08/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

JONES, DAMERON LEVEST

ART UNIT PAPER NUMBER

1618

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/773,823 | | KEPPLER, BERNHARD | |
| | Examiner | | Art Unit | |
| | D. L. Jones | | 1618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/31/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,6 and 7 is/are allowed.
- 6) ☒ Claim(s) 3-5 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 10/31/05 wherein 1 and 3-6 were amended and claims 7-10 were added.

Note: Claims 1-10 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS

2. The Applicant's arguments filed 10/31/05 to the rejection of claims 1-6 made by the Examiner under 35 USC 102 and/or have been fully considered and deemed persuasive-in-part for the reasons set forth below.

112 First Paragraph Rejections

The 112, first paragraph, rejections are WITHDRAWN because Applicant amended the claim to overcome the rejection.

112 Second Paragraph Rejections

The 112, second paragraph, rejections are WITHDRAWN because Applicant amended the claims to overcome the rejection.

102 Rejections

I. The rejection of claims 3-5 under 35 USC 102(b) as being anticipated by Golub et al (Zh. Obshch. Khim., 1969, 39(6), 1382-1387) is MAINTAINED for reasons of record in the office action mailed 6/30/05 and those set forth below.

Applicant asserts that the instant invention is distinguished over the cited prior art because the references were relied upon as disclosing a compound within the indicated formula made in water, but the claims have been amended such that the compound is in an effective amount to treat cancer.

Applicant's argument is found non-persuasive because the claims are product claims. Thus, the patentability of a product claim is dependent upon the components present, not the components present which are effective to treat cancer. For method claims, the phrase 'effective to treat cancer' would carry patentable weight. However, for Applicant's product claims, patentability is based on the components of the product. Thus, since both Applicant and the cited prior art disclose a compound encompassed by formula I and a pharmaceutical carrier, the prior art meets the limitations of Applicant's claims. In addition, it should be noted that components are inseparable from their properties, thus, the properties associated with Applicant's components (i.e., being effective to treat a cancer disease) would inherently be possessed by those of the cited prior art.

II. The rejection of claims 3 and 4 under 35 USC 102(b) as being anticipated by Eremin et al (Zh. Neorg. Khim., 1976, 21(2), 387-394) is MAINTAINED for reasons of record in the office action mailed 6/30/05 and those set forth below.

Applicant asserts that the instant invention is distinguished over the cited prior art because the references were relied upon as disclosing a compound within the indicated formula made in water, but the claims have been amended such that the compound is in an effective amount to treat cancer.

Applicant's argument is found non-persuasive because the claims are product claims. Thus, the patentability of a product claim is dependent upon the components present, not the components present which are effective to treat cancer. For method claims, the phrase 'effective to treat cancer' would carry patentable weight. However, for Applicant's product claims, patentability is based on the components of the product. Thus, since both Applicant and the cited prior art disclose a compound encompassed by formula I and a pharmaceutical carrier, the prior art meets the limitations of Applicant's claims. In addition, it should be noted that

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components are inseparable from their properties, thus, the properties associated with Applicant's components (i.e., being effective to treat a cancer disease) would inherently be possessed by those of the cited prior art.

ALLOWABLE CLAIMS

3. Claims 1, 2, 6, and 7 are distinguished over the prior art of record for reasons of record in the office action mailed 6/30/05.

CLAIM OBJECTIONS

4. Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Note: The claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious a method of treating cancer wherein a subject is administered a compound of formula I.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

February 6, 2006